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INTELLECTUAL PROPERTY ADMINISTRATION
FORT COLLINS, CO 80527-2400

EXAMINER

ROSEN, NICHOLAS D

ART UNIT	PAPER NUMBER
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3625

NOTIFICATION DATE	DELIVERY MODE
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05/30/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/840,221	Applicant(s) MORITA ET AL.	
	Examiner Nicholas D. Rosen	Art Unit 3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 April 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 7-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 7-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 May 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-4 and 7-19 have been examined.

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 30, 2008, has been entered.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 16 and 17 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The computer readable storage medium recited stores a "data structure," but the "data structure" is merely non-functional descriptive material, "used to display . . . a written estimate," but not specified as being computer-executable instructions which cause a computer to carry out a specific method. The "data structure" of claims 16 and 17 merely comprises "drawing information of the system which has been used to generate," and comprises "cost estimate information of the system which has been generated." The MPEP, 2106.01, quotes the New IEEE Standard Dictionary of Electrical and Electronics Terms (5th ed., 1993), defining a "data structure" as "a physical or logical relationship among data

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elements, designed to support specific data manipulation functions.” The “data structure” of claims 16 and 17 does not define such a physical or logical relationship among data elements, and nonfunctional descriptive material recorded on a computer-readable medium is not statutory, since no requisite functionality is present to satisfy the practical application requirement (“new and useful” in 35 U.S.C. 101). A particular instance of such a claimed “data structure” might be protected under the copyright law.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim 1

Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Holbrook et al. (U.S. Patent Application Publication 2003/0172003) in view of Schuller (U.S. Patent 6,882,980), Hehenberger et al. (U.S. Patent Application Publication 2003/0083902), and official notice. Holbrook discloses a system for drawing a system having a plurality of components that are to be combined, comprising: a merchandise information provider terminal adapted to be responsive to component arrangement information used to arrange the components on the drawing, responsive to estimate information used to calculate prices of the components (Abstract; paragraphs 5, 25, and 37), and responsive to a drawing-functional component diagram used to draw drawings of the components (Abstract; paragraphs 5-7, 25-33, 36, 37, 43, and 50; Figures 1 and 2; Appendix A, pages 8 and 9); a component arrangement information and estimate database for storing the component arrangement information and the estimate information adapted to be entered at the terminal (Abstract; paragraphs 5-7, 32, 33, and 37); and a diagram database for storing the component diagram data (paragraph 37); a Web and application server for receiving a request and a condition, which are used to form the drawing, and for forming the drawing (paragraphs 32 and 33; Figure 1). Holbrook does not expressly disclose a database server distinct from the Web and application server such that the Web and application server receives component arrangement information corresponding to the received condition from the database server, but Holbrook discloses that the invention can be practiced in distributed computing environments (paragraph 29), and distinct database servers are known, as taught, for example, by Hehenberger (Figure 2 and paragraph 33). Hence, it would

have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to include a database server for transmitting information, for the obvious advantage of coordinating information stored at multiple remote processing devices, as disclosed by Holbrook.

Holbrook discloses the Web and application server forming the drawing of the system in which components are to be combined, based on received component arrangement information and a selection of components and their relationships to each other (*ibid.*, as above). Holbrook does not disclose that the component diagram database comprises a physically separate database from the component arrangement information and estimate information database, although Holbrook does disclose that his invention can be practiced in a distributed computing environment (paragraph 29), but it is well known for database systems to implemented by a number of physically separate database systems, as taught by Schuller (column 6, lines 16-23). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have the component diagram database comprise a physically separate database from the component arrangement information and estimate information database, for the obvious advantage of storing data conveniently to where it is created or obtained, or for keeping data securely in the possession of its owners, or simply as a valid design choice among several.

Holbrook discloses that the component arrangement information includes the coordinates of a component (Abstract; paragraphs 25 and 26). Holbrook does not expressly disclose that the component arrangement information includes the size of the

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drawing, the scale of the drawing, an image frame, and a dimensional line, but official notice is taken that these are well known features of images, and that it is well known for diagrams to comprise arrangements of components, drawing of dimension lines, and arrangements of image frames. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the component arrangement information to include the size of the drawing, for at least the obvious advantage of providing a drawing of the proper size to make features readily visible, to fit on the display of a client device, etc.; the scale of the drawing, for at least the obvious advantage of aiding the user in judging the real-world size of the features shown; an image frame, for at least the obvious advantage of presenting at least one image in a series; and a dimensional line, for at least the obvious advantage of judging the size of objects in the drawing by comparison to the dimensional line; and to have the drawing-function component diagram include these features, for at least the obvious advantage of displaying the components in the desired arrangement.

Claims 2-4, 7, 8, 12, 14, 15, and 18

Claims 2, 3, 7, 12, 14, 15, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holbrook et al. (U.S. Patent Application Publication 2003/0172003) in view of Schuller (U.S. Patent 6,882,980), the Microsoft Press Computer Dictionary, and official notice. As per claim 2, Holbrook discloses a method of drawing a system in which a plurality of components are combined based on component diagram data having drawings of the respective components stored on a component diagram database, the method being performed with a computer, the method comprising:

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receiving component arrangement information used to draw the drawing from what can be called a component arrangement information and estimate information database (paragraphs 5-7, 25-33, 36, 37, 43, and 50; Figures 1 and 2; Appendix A, pages 8 and 9); generating, by using the processor (see paragraph 29 for processor), drawing information of the system based on the received component information and the component diagram data (Abstract; Figures 8A, 8B, and 12; paragraphs 36, 37, 43, and 50; Appendix A, pages 8 and 9). Holbrook does not disclose generating the drawing information as a bitmap object, but bitmap objects are well known, as taught, for example, by the Microsoft Press Computer Dictionary (page 53, definition of bit map, bitmapped font, and bitmapped graphics). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to generate the drawing information as a bitmap object, for at least the obvious advantage of being able to transmit it as computer data so as to enable the user to look at the drawing on his client computer.

Holbrook does not disclose that the component diagram database comprises a physically separate database from the component arrangement information and estimate information database, although Holbrook does disclose that his invention can be practiced in a distributed computing environment (paragraph 29), but it is well known for database systems to implemented by a number of physically separate database systems, as taught by Schuller (column 6, lines 16-23). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to have the component diagram database comprise a physically

separate database from the component arrangement information and estimate information database, for the obvious advantage of storing data conveniently to where it is created or obtained, or for keeping data securely in the possession of its owners, or simply as a valid design choice among several.

Holbrook does not expressly disclose that there is a volatile memory, or that the bitmap object is stored in the volatile memory, but volatile memory is well known, as taught, for example, by the Microsoft Press Computer Dictionary (page 502, definition of volatile memory). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to store the bitmap object in the volatile memory, for such obvious advantages as temporarily storing data to be transmitted in reusable memory immediately before and during transmission to the user's client computer.

Holbrook discloses that the component arrangement information includes the coordinates of a component (Abstract; paragraphs 25 and 26). Holbrook does not expressly disclose that the component arrangement information includes the size and scale of the components of the drawing, an image frame, and a dimensional line, but official notice is taken that these are well known features of images, and that it is well known for diagrams to comprise arrangements of components, drawing of dimension lines, and arrangements of image frames. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the component arrangement information to include the size of the drawing, for at least the obvious advantage of providing a drawing of the proper size to make features readily

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visible, to fit on the display of a client device, etc.; the scale of the drawing, for at least the obvious advantage of aiding the user in judging the real-world size of the features shown; an image frame, for at least the obvious advantage of presenting at least one image in a series; and a dimensional line, for at least the obvious advantage of judging the size of objects in the drawing by comparison to the dimensional line; and to have the drawing-function component diagram include these features, for at least the obvious advantage of displaying the components in the desired arrangement.

As per claim 3, displaying drawings, etc. to the user, the user being at a client computer remote from the server (e.g., Abstract; Figure 1; paragraphs 5-7, 29, 33, 36, 43, and 50) requires transmitting the bitmap (or other drawing) object to the user.

As per claim 7, Holbrook discloses merchandise information provider terminals (client computers) separate from a central server computer (Figure 1; paragraphs 31-33, and 35); Holbrook discloses in a merchandise information provider terminal receiving component arrangement information (paragraphs 36, 37, and 43; Figure 2), and storing component arrangement information in what can be called a component arrangement information and estimate information database (paragraphs 36, 37, and 43; Figure 2; Appendix A, pages 8 and 9), and receiving drawing-functional component diagrams and storing the drawing-functional component diagrams in a component diagram database (paragraphs 6, 7, 36, 37, and 43; Figure 2; Appendix A, pages 8 and 9).

As per claim 12, claim 12 recites a drawing as formed by the method of claims 2 and 3, and is therefore obvious on the same grounds set forth above.

(Claim 12 would be unpatentable in any event, because system drawings are known, and the content of printed matter will not distinguish the claimed product from the prior art. See *In re Ngai*, 367 F.3d 1336, 1339, 70 USPQ2d 1862, 1864 (Fed. Cir. 2004).)

As per claim 14, claim 14 recites a computer program product stored on a computer readable storage medium for causing a computer to perform the method of claim 2, and **as per claim 15**, claim 15 additionally recites causing the computer to perform the step of claim 7. Holbrook discloses programs for causing the server of his system to perform its functions (e.g., Abstract; paragraph 33), and discloses programs in memory storage devices, which are storage media (paragraph 29). Hence, claims 14 and 15 are obvious on the same grounds set forth above.

As per claim 18, Schuller discloses geographically distributed computers connected by a network, and discloses that a database system that may include a number of physically separate database systems each having their own computer processing as well as data storage facilities (column 6, lines 4-23). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to implement a database server to transmit the component arrangement information from the component arrangement information and estimate information database to the computer, wherein the computer comprised a web and application server, and the wherein the database server and the web and application server comprised different machines, as an obvious consequence of physically separate database systems each having their own computer processing as well as data storage

facilities, done for the obvious advantage of storing data conveniently to where it is created or obtained, or for keeping data securely in the possession of its owners, or simply as a valid design choice among several.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Holbrook, Schuller, the Microsoft Press Computer Dictionary, and official notice as applied to claim 3 above, and further in view of Jaisimha et al. (U.S. Patent 6,487,663). Holbrook does not disclose that transmitting the bitmap object includes transmitting the bitmap object by streaming, but it is well known to transmit objects by streaming, as taught, for example, by Jaisimha (column 4, line 66, through column 5, line 10; column 5, lines 21-29); hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to transmit the bitmap object by streaming, for at least the obvious advantage of enabling users to begin viewing and accessing the object before it has been completely transmitted.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Holbrook, Schuller, the Microsoft Press Computer Dictionary, and official notice as applied to claim 2 above, and further in view of Smith et al. (U.S. Patent Application Publication 2003/0046003). Holbrook does not disclose that the bit map object is a perspective view, but it is well known for computers to display objects or groups of objects in perspective view (Figures 8A and 8B of Holbrook appear to qualify), and Smith, for example, clearly teaches a for computer displaying objects in perspective view (paragraphs 134, 138, and 139; Figure 9). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention for the

bitmap object to be a perspective view, for the obvious advantage of enabling users to see the arrangement as it would appear from a particular point.

Claims 9-11, 13, 16, 17, and 19

Claims 9, 10, 13, 16, 17, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holbrook et al. (U.S. Patent Application Publication 2003/0172003) in view of Schuller (U.S. Patent 6,882,980), the Microsoft Press Computer Dictionary, and official notice. Claim 9 recites a number of the same elements as claim 2, and these are rejected on the same grounds set forth above for claim 2. Claim 9 additionally recites generating, by using the processor, estimate information of the system based on the received component arrangement information and price data. Holbrook additionally discloses generating estimate information of the system based on the received component arrangement information and price data (e.g., Abstract; paragraphs 5, 25, and 37). Holbrook does not expressly disclose forming a written estimate, but even taking this to be a limitation of claim 9, despite the word “written” appearing only in the preamble, without any explicit step of writing in the body of the claim, Holbrook discloses the client computers having printers as output devices (paragraph 31), which would enable reports provided to users (as per paragraph 25) to be printed. Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant’s invention to form a written estimate, for the obvious advantage of maintaining hardcopy documentation for ready consultation away from the computer.

As per claim 10, Holbrook discloses merchandise information provider terminals (client computers) separate from a central server computer (Figure 1; paragraphs 31-

33, and 35); Holbrook discloses in a merchandise information provider terminal receiving component arrangement information (paragraphs 36, 37, and 43; Figure 2), and storing component arrangement information in what can be called a component arrangement information and estimate information database (paragraphs 36, 37, and 43; Figure 2; Appendix A, pages 8 and 9), and receiving drawing-functional component diagrams and storing the drawing-functional component diagrams in a component diagram database (paragraphs 6, 7, 36, 37, and 43; Figure 2; Appendix A, pages 8 and 9).

As per claim 13, claim 13 recites a written estimate as formed by the method of claim 9, and also Holbrook discloses providing a report including total cost (paragraph 25), which implies transmitting the estimate information. For the transmission of the bitmap object, displaying drawings, etc. to the user, the user being at a client computer remote from the server (e.g., Abstract; Figure 1; paragraphs 5-7, 29, 33, 36, 43, and 50) requires transmitting the bitmap (or other drawing) object to the user.

(Claim 13 would be unpatentable in any event, because written estimates are known, and the content of printed matter will not distinguish the claimed product from the prior art. See *In re Ngai*, 367 F.3d 1336, 1339, 70 USPQ2d 1862, 1864 (Fed. Cir. 2004).)

As per claims 16 and 17, Holbrook, Schuller, and the Microsoft Press Computer Dictionary make obvious providing drawing information and cost estimate information in a computer system, as set forth above; therefore the data structure used to display the written estimate on a terminal apparatus is likewise obvious, for the obvious advantage

of causing the estimate to be displayed and thus made available. Furthermore, Holbrook discloses programs in memory storage devices, which are storage media (paragraph 29).

As per claim 19, Schuller discloses geographically distributed computers connected by a network, and discloses that a database system that may include a number of physically separate database systems each having their own computer processing as well as data storage facilities (column 6, lines 4-23). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to implement a database server to transmit the component arrangement information from the component arrangement information and estimate information database to the computer, wherein the computer comprised a web and application server, and the wherein the database server and the web and application server comprised different machines, as an obvious consequence of physically separate database systems each having their own computer processing as well as data storage facilities, done for the obvious advantage of storing data conveniently to where it is created or obtained, or for keeping data securely in the possession of its owners, or simply as a valid design choice among several.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Holbrook, Schuller, the Microsoft Press Computer Dictionary, and official notice as applied to claim 9 above, and further in view of Dunne et al. (U.S. Patent 5,938,717). Holbrook does not expressly disclose storing the generated estimate information and an identification number that specifies said estimate information, whereby the written

information can be retrieved, but it is well known to save information and an identification number or name specifying the saved information, whereby the information can be retrieved, as taught, for example, by Dunne (column 7, lines 38-64). Hence, it would have been obvious to one of ordinary skill in the art of electronic commerce at the time of applicant's invention to store the generated estimate information and an identification number that specifies said estimate information, whereby the written information can be retrieved, for the obvious advantage of being able to find and retrieve the generated estimate information, should a user wish to return to a previously designed system of components.

Response to Arguments

Applicant's arguments filed April 30, 2008 have been fully considered but they are not persuasive. First, with regard to the rejections of claims 16 and 17 under 35 U.S.C. 101, Applicant refers to *In re Lowry*, 32 F.3d, 1579, 1583-84 (Fed. Cir. 1994) for the precedent that a claim that recites a specific electronic structural element which imparts a physical organization on information that is stored in memory is a claim that recites functionally descriptive statutory subject matter. Examiner replies that Applicant's claims 16 and 17 do not meet the test of imparting a particular physical organization on data. Examiner also refers Applicant to *In re Warmerdam*, 33 F.3d, 1354 (Fed. Cir. 1994), for the precedent that a claimed "data structure" which describes only the manipulation of abstract ideas is not patentable.

With regard to the rejections under 35 U.S.C. 103, in particular the rejection of claim 1, Applicant traverses Examiner's taking of official notice; Examiner, in response, has made Hehenberger of record to provide an example of a database server distinct from the web server with which it interacts. Applicant argues that Holbrook teaches away from the claimed invention because Holbrook teaches storing the entirety of each previously drawn furniture item in the same location. Examiner replies that this is dubious in light of paragraph 29 of Holbrook, which states that the invention can be practiced in distributed computing environments, and also that not every teaching of a practice different from a claimed element constitutes teaching away from that element. Even if Holbrook assumed that the entirety of each previously drawn furniture item would be stored in the same location, there is no teaching in Holbrook that it would be impossible or undesirable to do things differently, and therefore no real teaching away. And there is, as mentioned, paragraph 29, which indicates that Holbrook and Shannon were flexibly minded about how their invention could be implemented.

Further, Applicants argue that the previous Office Action (and presumably this would apply to the present Office Action) is based on an interpretation of the claims which contradicts Applicant's specification. Examiner replies, first, that it is proper, in the course of examination, to give claims their broadest reasonable interpretation, as is set forth in the MPEP, §2111, to which Applicant makes reference. If Applicant believes that claim 1 should be allowable over the prior art applied because the "component arrangement information" and "drawing-functional component diagram" are not created separately, not obtained separately, and not stored with the owner (merchant), then a

reasonable course of action would be to incorporate those elements as actual limitations of the claim. It is also noted that Applicant refers to paragraph [0019] of the specification (p. 3, line 25, through p. 4, line 18), beginning, "In accordance with one aspect of the present invention," but this is followed by paragraph [0020], beginning, "In accordance with another aspect of the present invention," and paragraphs [0026] through [0030], each of which begins, "In accordance with a further aspect of the present invention," and then by the Brief and Detailed Descriptions of the Drawings. Citing one paragraph, which describes one aspect of the invention without excluding others, is not sufficient to establish that a particular arrangement is altogether incompatible with the specification.

As to Applicant's argument that "a valid design choice among several" is not necessarily a proper rationale for determining obviousness, Examiner replies, as a minor point, that "design choice" can in some circumstances be a proper basis for rejection (*In re Kuhle*, 526 F.2d 553, 188 USPQ 7 (CCPA 1975)). More importantly, Examiner's rejection of claim 1 did not depend simply on "a valid design choice among several," but gave as motivation, "for the obvious advantage of storing data conveniently to where it is created or obtained, or for keeping data securely in the possession of its owners, or simply as a valid design choice among several." Thus, there is motivation to make the combination without depending on design choice.

The arguments made with respect to claims 2, 12, and 14 are largely parallel to those made with respect to claim 1, and found similarly unpersuasive. Applicant also argues that the definitions of "bit map" and "volatile memory" from the Microsoft Press

Computer Dictionary do not overcome the deficiencies of the other prior art. Examiner replies that valid motivations are given to use a bitmap and a volatile memory. While elements would not necessarily be obvious in a particular context merely because they were known and described in a relevant technical dictionary, the existence of such a dictionary, listing the elements and advantages of using them, surely presents a barrier for a patent applicant to overcome. Applicants have not refuted Examiner's prima facie case for obviousness by offering any explanation of why it would be non-obvious to use a bitmap where it would have been obvious to use some other kind of data structure to represent an image.

Contrary to Applicant's interpretation, Examiner's previous Office Action did not suggest that it would be proper to rely on non-cited portions of the Microsoft Press Computer Dictionary and still assert the "same" grounds of rejection. Examiner wrote, "something else in the Microsoft Press Computer Dictionary might supply other deficiencies of Holbrook (although in fact Schuller is used)." If some other page of the Microsoft Press Computer Dictionary were to be introduced as prior art, it would be a new ground of rejection.

Regarding *Ngai*, Applicant makes the point that printed matter can be patented in some situations, one being when it is functionally related to a substrate. Examiner accepts the principle, but disputes that it applies to the current situation. Applicant's drawings are not *functionally* related to the volatile memory in which they are stored, or the stored data used as a basis for drawing the drawings. The MPEP, §2106.01, to which Applicant refers, teaches, "USPTO personnel need not give patentable weight to

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printed matter absent a new and unobvious functional relationship between the printed matter and the substrate,” and also gives as an example, “nonstatutory music is not a computer component, and it does not become statutory by merely recording it on a compact disk.” The particulars of Applicant’s drawing may be compared to the particulars of a song or symphony.

Regarding claims 4 and 8, and also claim 11, Examiner has applied actual prior art in response to Applicant’s traversals of official notice, questionable though these traversals be (see below). Applicant’s arguments regarding claims 9, 13, 16, and 17 are largely parallel to arguments made for earlier claims, and found unpersuasive.

Regarding claim 11, Applicant argues that it is not well known to save the particularly claimed information, which may well be, but saving information is very well known, and applied in a variety of contexts to various particular kinds of information. As set forth above, there is motivation to save information, and no reason why one of ordinary skill in the art, if called upon to deal with the particulars of Applicant’s invention, would not be likely to save the particularly claimed information. It may not be well known to write certain particularly claimed information using the Roman alphabet, or discuss it in a conversational tone of voice, but that does not make it patentable to do so.

The Manual of Patent Examination Procedure (2144.03 (C)) states, in regard to traversal of Official Notice:

C. If Applicant Challenges a Factual Assertion as Not Properly Officially Noticed or not Properly Based Upon Common Knowledge, the Examiner Must Support the Finding with Adequate Evidence.

To adequately traverse such a finding, an applicant must specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. See 37 CFR 1.111(b). See also Chevenard, 139 F.2d at 713, 60 USPQ at 241 ("[I]n the absence of any demand by appellant for the examiner to produce authority for his statement, we will not consider this contention."). A general allegation that the claims define a patentable invention without reference to the examiner's assertion of official notice would be inadequate.

Applicant's traversals of official notice in claims 1, 4, 8, and 11 in the previous Office action do not state why the noticed fact is not considered to be common knowledge, and are therefore inadequate. Nonetheless, Examiner has made prior art of record to explicitly teach the facts relied upon as being well known.

The common knowledge or well-known in the art statements in the previous office action which Applicant did not traverse are taken to be admitted prior art, because Applicant did not traverse Examiner's taking of official notice. Specifically, the taking of official notice in claim 6 (now cancelled) was not traversed, and official notice is now taken in the rejections of claims 1 and 2, and elsewhere, referring to claim elements similar to the language of former claim 6.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Yoshida et al. (U.S. Patent 5,950,551) disclose a sewing machine system having a data editing device; this is relevant for the teaching in column 1, lines 29-42, of storing files with identifying numbers. Wong (U.S. Patent 7,058,623) discloses a computer automated system for management of engineering drawings. Wright (U.S. Patent Application Publication 2002/0165857) discloses a collection management system, and is of some relevance for supporting Examiner's observation in the previous Office action that perspective has been known at least since the Renaissance (paragraph 44).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicholas D. Rosen, whose telephone number is 571-272-6762. The examiner can normally be reached on 8:30 AM - 5:00 PM, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith, can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Non-official/draft communications can be faxed to the examiner at 571-273-6762.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic

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Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Nicholas D. Rosen/
Primary Examiner, Art Unit 3625
May 23, 2008